

### C. Remarks

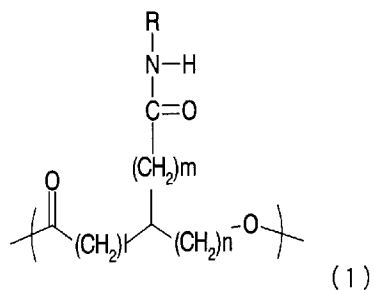
The claims are 1-10, with claims 1, 3, 4 and 6-10 being independent.

Claims 3, 4 and 6-9 have been withdrawn from consideration as being directed to non-elected subject matter. Claims 1, 2, 5 and 10 have been amended solely as to form. No new matter has been added. Reconsideration of the claims is expressly requested.

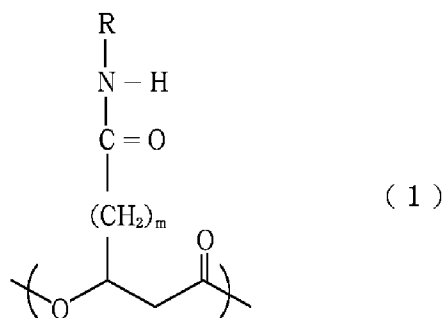
Initially, as required, Applicants affirm the election of claims 1, 2, 5 and 10.

Claims 1, 2, 5 and 10 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious from WO 2004/061530 (Mihara). The grounds of rejection are respectfully traversed.

The presently claimed invention, in pertinent part, is related to a polyhydroxyalkanoate that includes one or more units represented by chemical formula (1):



Mihara discloses a PHA, which has a unit with the following structure:



The Examiner indicated that formula (1) in the present claims is a homologue of the above formula (1) in Mihara, with the sole difference residing in the number of CH<sub>2</sub> groups between the oxygen and the side chain, i.e., Mihara does not teach the same “n” as presently claimed. However, the Examiner alleged that the presently claimed invention is *prima facie* obvious from Mihara since, as homologues, the PHA in the present claims and the PHA in Mihara would have been expected to have similar properties, particularly with respect to hydrophobicity. Applicants respectfully disagree with the Examiner.

Applicants respectfully submit that a person skilled in the art would appreciate that a modification of the backbone of the PHA would change the physical properties of the PHA. In accordance with the present invention, the physical properties of the PHA can be controlled by changing the number of CH<sub>2</sub> groups in the backbone of the unit of formula (1).

Regardless, Applicants respectfully submit that Mihara is not prior art. Specifically, the present application is a U.S. national stage of International Application

No. PCT/JP2005/010998, which was filed on June 9, 2005 and claims priority from Japanese Application No. 2004-174784, filed on June 11, 2004.<sup>1</sup> Mihara was filed on December 23, 2003 and published on July 22, 2004. Thus, Mihara was published after the filing date of priority Japanese Application No. 2004-174784. While Mihara was filed before the priority Japanese application, it can only qualify as prior art under 35 U.S.C. 102(e) based on its filing date. However, since Mihara and the claimed invention were, at the time the invention was made, owned by, or subject to an obligation of assignment to, Canon Kabushiki Kaisha,<sup>2</sup> Mihara cannot be used as prior art in an obviousness rejection in view of 35 U.S.C. § 103(c).

Wherefore, Applicants respectfully request withdrawal of the outstanding rejection and expedient passage to issue of the subject application.

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<sup>1</sup> To perfect the foreign priority claim in accordance with 37 C.F.R. § 1.55, Applicants submit herewith a sworn translation of JP 2004-174784.

<sup>2</sup> Assignments of the subject application to Canon is recorded at reel/frame 017567/0487.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

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